

Appl. No. 10/789,455
Amdt. dated June 20, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2876

PATENT

REMARKS/ARGUMENTS

Claims 1-27 were pending in this application. Claims 1, 10, 13, and 21 have been amended. No claims have been added or canceled. Hence, claims 1-27 remain pending.

Reconsideration of the subject application as amended is respectfully requested.

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over of the cited portions of U.S. Patent No. 6,877,656 to Jaros, *et al.* (hereinafter "Jaros"), and further in view of the cited portions of U.S. Patent No. 5,799,316 to Audren, *et al.* (hereinafter "Audren").

Claims 1, 10, 13, and 21 stand objected to due to informalities.

Claims 1, 10, 13, and 21 have been amended to correct the informalities.

Claim Objections

Claims 1, 10, 13, and 21 have been amended to correct the informalities by replacing "that may be used" with "usable." Hence, a presentation instrument must be a physical object usable to settle a financial transaction. Such language is not optional. If a physical device is not "usable to settle a financial transaction," then it does not anticipate the claim.

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejection of all claims since the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations and the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

Appl. No. 10/789,455
Amtd. dated June 20, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2876

PATENT

With respect to the third prong of the test, neither Jaros nor Audren teach "sending one or more files that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments." Audren teaches a card production system and has nothing to do with ordering cards. While Jaros relates to ordering cards, Jaros says nothing about display screens for collecting purchase information. Further, neither reference teaches "delivering the presentation instruments in accordance with the purchase information." For at least these reasons, claims 1, 10, 13, and 21 are believed to be allowable.

Moreover, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Jaros with those of Audren to achieve the Applicants' claimed invention. The Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner.

(MPEP § 2144.03, emphasis added, citing 37 CFR §1.104(d)(2)) Because no reference is cited that provides the teaching, suggestion, or motivation to combine the references, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. (Note that even though the office action implies the knowledge is generally available to one of ordinary skill in the art, there is no reference supporting this assertion. Hence, the

Appl. No. 10/789,455
Amdt. dated June 20, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2876

PATENT

assertion appears to originate in the mind of the Examiner. If the knowledge is generally known to one of ordinary skill in the art, then the Applicants request documentary proof of this.) The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2).

Further still, claim 3 recites "delivering the presentation instruments to each of a plurality of recipients." The office action admits that this limitation is not taught by either reference. The office action states, however, that "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to implement into the operating software of Jaros et al. a subroutine prompting the requestor as to whether the card should be mailed/delivered the presentation instrument to each of a plurality of recipients, or a designee." This is not a valid grounds for rejection. In a claim rejection under 35 USC §103, the office action must establish *prima facie* obviousness by citing a reference for all the claim limitations. If a limitation is not present in the prior art, which is precisely the case here, the office action cannot simply add the limitation to the prior art to thereby reject the claims. Hence, claims 3 and 5 are believed to be allowable for this additional reason.

Claims 6, 12, 14, and 24 are believed to be allowable for the additional reason that neither reference teaches "receiving at the host computer system a request from a user to view usage information relating to a presentation instrument; and sending a file to a computer of the user, wherein the file comprises the usage information." According to the office action, this is taught at Col. 7 of Jaros. At this location, however, Jaros discusses a secured card tracking system but teaches nothing related to usage information, much less a file of usage information sent to a computer of the user.

Claim 20 is believed to be allowable since neither reference teaches non-personalized cards. In rejecting the claim, the office action even states that conventional credit card embossing standards include name of cardholder, which is the antithesis of a "non-personalized card."

Appl. No. 10/789,455
Amdt. dated June 20, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2876

PATENT

Summary

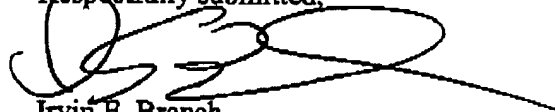
Claims 1, 10, 13, and 21 are believed to be allowable for the specific reasons stated above. The remaining claims depend either directly or indirectly from the independent claims and are believed to be allowable because they depend from allowable independent claims and because of the additional specific reasons stated above, where applicable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
60482222 v1